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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/171,553	02/09/99	GALBRAITH	D CFV-005.01

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How 40913

EXAMINER
SHUKLA, R
1632
NUMBER

DATE MAILED:

09/13/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

**Office Action Summary**

Application No.

09/171,553

Applicant(s)

GALBRAITH ET AL.

Examiner

Ram Shukla

Art Unit

1632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 May 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 43-65 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 43-65 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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### DETAILED ACTION

1. Amendment filed 5-3-01 has been entered.
2. It is noted that the amendment cancels claims 1-43 and adds new claims 44-66. However, as noted in the previous office action, claims 32-43 filed in the amendment filed on 7-24-00 were renumbered as claims 31-42, as per 37 CFR 1.126, therefore, only claims 1-42 were filed in the application before the amendment filed 5-3-01. Accordingly, claims 1-42 have been canceled in response to the amendment filed 5-3-01 and the newly presented claims have been renumbered as 43-64. <sup>5</sup> ~~43-64~~ <sup>44-66</sup>
3. New claims recite more than one SEQ ID NO. For example, claims 43, 49, and 62 recite 4 sequences, SEQ ID NO 1, 2, 3, and 9. Claim 48 recites SEQ ID NO 4, 5, 6 and 10. SEQ ID NO 1, 2, 3, and 9 encode the protein sequence of SEQ ID NO 4, 5, 6, and 10 respectively. Claims 57 and 63 recite SEQ ID NO 7, 8, 11, 12, 13, and 14. It is further noted that while claims 43-64 are drawn to polynucleotides, vector comprising polynucleotides, detection kit, oligonucleotide primers, and method of detecting the presence of a polynucleotide in a sample, claim 65 is drawn to an antisense oligonucleotide that suppresses expression of different polypeptides of PoEV.
4. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 43-64, drawn to polynucleotides that encode GAG, ENV and POL polypeptides of PoEV, vector comprising polynucleotides, detection kit, oligonucleotide primers, and method of detecting the presence of a polynucleotide in a nucleic acid sample, classified in class 435, subclass 6.

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II. Claim 65, drawn to an antisense oligonucleotide that suppresses expression of a PoEV GAG, POL, or ENV polypeptide, classified in class 514, subclass 44.

5. Claims 57 and 63 are generic to a plurality of disclosed patentably distinct species comprising SEQ ID NO 7, 8, 11, 12, 13, AND 14.. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed. Due to the limited nucleic acid search resources at PTO and multiple sequences recited in these claims, Applicants are required to elect a single SEQ ID NO.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

6. Although there are no provisions under the section for "Relationship of Inventions" in MPEP 806.05 for inventive groups that are directed to different methods, restriction is deemed to be proper because these methods appear to constitute patentably distinct inventions for the following reasons:

7. It is noted that the inventions of the group I and II are patentably distinct each from the other because the method steps of the invention of group I can not be used in practicing the method of group II. Furthermore, the polynucleotides used in the invention of group I may not be used in the method of group II because the only characteristic of the oligonucleotides used in group I would be their sequence structure, however, the characteristics of the oligonucleotides of group II has to include hybridization to a certain part of the disclosed polynucleotide sequences of SEQ ID NO 2,3 or 9, in such as way as to inhibit gene expression. Therefore, a search for the analysis of the invention of group I would not be co-extensive with the search for the analysis of the invention of group II.

8. Because these inventions are distinct for the reasons given above, have acquired a separate status in the art shown by their different classification and their recognized divergent subject matter, and because each invention requires a separate, non-coextensive search, restriction for examination purposes as indicated is proper.


Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Applicants are advised to submit a clean version of each amended claim (without underlining and bracketing) according to § 1.121(c) and a copy of all the pending/under consideration claims. For instructions, Applicants are referred to <http://www.uspto.gov/web/offices/dcom/olia/aipa/index.htm>.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ram R. Shukla whose telephone number is (703) 305-1677. The examiner can normally be reached on Monday through Friday from 7:30 am to 4:00 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Karen Hauda, can be reached on (703) 305-6608. The fax phone number for this Group is (703) 308-4242. Any inquiry of a general nature, formal matters or relating to the status of this application or proceeding should be directed to the Kay Pinkney whose telephone number is (703) 305-3553.

Ram R. Shukla, Ph.D.

  
DAVE T. NGUYEN  
PRIMARY EXAMINER